

Attorney Docket No. YOR9-1999-0183

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re PATENT APPLICATION Of:

Dimitri KANEVSKY et al.

Appln. No. : 09/343,758

Filed : June 30, 1999

For : SYSTEM AND METHOD FOR  
TRANSFERRING INFORMATION  
OVER A NETWORK

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Art Unit: 2173  
Examiner: Kieu VU

OCT 07 2005

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Mail Stop APPEAL BRIEF – PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir,

Submitted herewith are:

Reply Brief (5 pages)

Total number of pages 6 (including this cover sheet)

Please charge any deficiencies in fees and credit any overpayment of fees to attorney's deposit account no. 50-0510 and advise us accordingly.

I hereby certify that the above listed documents are being transmitted by fax to the Commissioner for Patents, United States Patent and Trademark Office, Washington, D.C. 20231, at fax no. (571) 273-8300, this Friday, October 07, 2005.

Respectfully submitted,



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P.O. Box 1450  
Alexandria, VA 22313-1450REPLY BRIEF UNDER 37 CFR §41.41**PROCEDURAL**

An Appeal brief was filed in the above identified application on May 16, 2005, pursuant to 37 U.S.C. § 41.37(a). However, in the August 11, 2005 Examiner's Answer, it is asserted that “[t]he rejection of claims 1-5, 7-21, 23-25, and 33-37 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).” (emphasis added.) However, 37 CFR 1.192(c)(7) was no longer in effect at the time of filing the Appeal Brief.

Appellants note that there is no provision for a grouping of claims under 37 U.S.C. §41, which was the governing rule at the time the Appeal Brief was filed. *See also*, slide 17 in the slide set on the final rule (41) published on the USPTO web site at [www.uspto.gov/web/offices/pac/dapp/opla/presentation/bpaislides.ppt](http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/bpaislides.ppt). As grounds of rejection

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to be reviewed on appeal have been indicated in the Appeal Brief §VI, and argued independently in §VII, the claims are not grouped to stand or fall together.

#### REJECTION UNDER 35 U.S.C. §102(a)

35 U.S.C. §102(a) provides in pertinent part that the invention be “described in a printed publication ..., before the invention thereof by the applicant for patent, ... .” Thus, a 35 U.S.C. §102(a) reference may be applied to the invention as recited in the claims by showing the exact description of all claim elements in the reference, or of equivalent elements. Differences with literal elements described in the 35 U.S.C. §102(a) reference and with equivalent elements, must be reflected in the claims. However, an equivalent element must perform “the identical function specified in the claim(s) in substantially the same way,” and produce “substantially the same results as the corresponding element disclosed in the specification.”<sup>1</sup>

In particular, as described, with reference to Figures 1 – 2, presented as Exhibits A – B in the appeal brief, the present invention functions substantially differently and provides a quite different result than as described in James, *Official Netscape Navigator 3.0 Book, Windows Edition: The Definitive Guide to the World's Most Popular Internet Navigator*, (hereinafter James), 1996 for figures 8-15 and 16 and the placekeeper icon, presented as Exhibits C – D. However, it is alleged in the Examiner's Answer (hereinafter Answer) that, “it is clear that James teaches a web browser (Netscape) wherein specific objects (Images) are replaced by generic objects (placeholders) such that the results represent the original with the data content discernable from the representation (one can easily see that placeholders in Fig. 8-16 are discernable from the representation by having different locations and dimensions).” Certainly, this speaks of a different result than is described in the present specification.<sup>2</sup> Furthermore, one

<sup>1</sup> *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000).

<sup>2</sup> Specific “sketches, clip art images, cartoons, commonly used images (e.g. forests, animals...), melodic sequences, 3-D graphics for virtual reality environments, tactile information for virtual reality environments, wave files, etc.” are each replaced with general representations of the same thing. So, for example, a herd of 20 cows is replaced with 20 instances of the same cow. Specification page 5, lines 3 – 8

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would not send a "modified digital image (with generic rather than specific objects) to a client system for display"<sup>3</sup> as described in the present application using Netscape Navigator.

The Appellants have noted that James (substituting the placeholder icon for every image, regardless of what the image portrays) certainly does not teach "storing a plurality of generic objects, each stored generic object corresponding to an original object in data requested from said remote computer system" as recited in claims 14 and 34 at lines 5 – 6. To this, the Answer responds that, "the claims do not recite the limitation 'image portrays'." Regardless, this difference certainly shows that the alleged anticipating reference does not perform "the identical function specified in the claim(s) in substantially the same way," and produce "substantially the same results as the corresponding element disclosed in the specification."<sup>4</sup>

The Appellants further have noted that James fails to indicate how the icon is generated. To this the Answer, responds "that such is not quite the case since the claims do not cite how a generic object (corresponding to icon or placeholder in James' teaching) is generated." Similarly, to the Appellants have averred that the James placeholder icon is not being supplied independently by the originating site; the Answer, responds "that such is not quite the case since the claims do not recite that generic object (corresponding to icon or placeholder in James' teaching) is being supplied independently by the originating site." Claim 1 et seq., clearly recite that "substituted said corresponding generic objects [are] transferred with said data before associated objects."<sup>5</sup>

Regarding the averment that allowing for a slow modem connection by turning off the James Auto-Load Graphics option, does not teach that "data transfer constraints include a peak net traffic constraint, a client quick mode constraint, a server quick mode constraint and an importance level"<sup>6</sup>; the Answer responds that "it is noted that Fig. 8-15 in page 360 illustrates a

<sup>3</sup> Claim 17, line 10 and 35, line 9.

<sup>4</sup> *Kemco Supra*.

<sup>5</sup> Claim 1, lines 9 – 10.

<sup>6</sup> Claim 8.

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normally displayed web browser image with the Auto Load images option.” Perhaps, but again this difference certainly shows that the alleged anticipating reference does not perform “the identical function specified in the claim(s) in substantially the same way,” and produce “substantially the same results as the corresponding element disclosed in the specification.”<sup>7</sup>

Regarding the averment that James teaches that upon coming “across a particular document whose graphics you want to view, you can easily display them by clicking the Images button;” it is very clear that one identifies which particular documents those are, not by the placeholder icons, but by displayed text; the Answer responds that “this argument is irrelevant in the context of the claims since the claims are silent regarding how a particular document is identified.” Again, this response ignores that the alleged anticipating reference does not perform “the identical function specified in the claim(s) in substantially the same way,” and produce “substantially the same results as the corresponding element disclosed in the specification.”<sup>8</sup>

Finally, the Appellants’ averred by example in the Appeal Brief that if a “particular web page includes a single image and no text, Netscape 3.0 with imagers blocked displays only the single placeholder icon. All that this conveys is that the page includes something but give no clue to what is included. By contrast, at the very least, the same page displayed according to the present invention would include a generic representation of the omitted image.”<sup>9</sup> The Answer responds that in “Figure 8-16, the top placeholder icon clues a viewer that the page includes at least an image displayed at the position where the placeholder is, the image is having the same size with that of the placeholder icon, and the content of the image relates to ‘\_\_\_\_\_’.”<sup>10</sup> Of course, as with this description with the text omitted from the example, the webpage viewer is left clueless regarding web page content.

<sup>7</sup> *Kemco, Supra.*

<sup>8</sup> *Id.*

<sup>9</sup> Appeal Brief, page 15, lines 1 – 5 (emphasis added).

<sup>10</sup> Examiner’s Answer, pages 12 – 13, “SportsLine USA” omitted.

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Accordingly, without reading things into James that are not there, James could not result from the illustrated example of Figures 1 and 2 in Exhibits A and B of the appeal brief, and claimed by finally rejected claims 1 – 5, 7 – 21, 23 – 25 and 33 – 37. Therefore, because the allegedly equivalent elements do not perform “the identical function specified in the claim(s) in substantially the same way,” and do not produce “substantially the same results as the corresponding element disclosed in the specification”<sup>11</sup>; and, because the combination of the elements does not result in the present invention; the elements, cited in the James as equivalent, are not *prime facie* equivalents. Appellants respectfully request that the board reverse the rejection of claims 1 – 5, 7 – 21, 23 – 25 and 33 – 37 under 35 U.S.C. §102(a) and pass the application to issue.

Respectfully submitted,



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<sup>11</sup> *Kemco, Supra.*